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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/438,516	11/12/1999	KIM B. ROBERTS	10799ROUS01U	9470

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CANADA

EXAMINER

JONES, PRENELL P

ART UNIT	PAPER NUMBER
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2664

DATE MAILED: 02/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

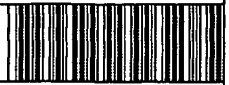
Office Action Summary

Application No.
09/438,516

Applicant(s)
Roberts et al

Examiner
Prenell Jones

Art Unit
2664



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov 12, 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18-22 is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5, 6, 8-10, 13, 14, 16, and 17 is/are rejected.
- 7) ☒ Claim(s) 2, 4, 7, 11, 12, and 15 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 6) ☐ Other:

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Claim Rejections - 35 U.S.C. § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1, 3, 5, 6, 8-10, 13, 14, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hershey et al in view of Miller et al.

Regarding claims 1, 3, 5, 6, 8-10, 13, 14, 16 and 17, Hershey discloses synchronization and control in a telecommunication adj system that includes (col. 1, line 16-54, col. 6, line 1-8) transmitting in a high speed network , transmission of multi-protocol signals associated with contemporary systems (col. 4, line 61-67, col. 5, line 27-46) FPGA (programmable link termination/programmable link instigation) which provides

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dynamic configuration of network in accordance with performance parameters and configuration of programmable device depends on protocol technology. Hershey is silent on transparent system with a receiver that extracts data signals and data clock. In analogous art, Miller discloses a spectrum receiver wherein (Abstract, col. 4, line 50-61) high data rate (SONET) information is received, receiver strips (col. 5, line 37-50, col. 8, line 44-60) data from signal, extracting timing information (col. 13, line 16-26), (col. 26, line 37-47) FPGA provides frame synchronization, transmission is done in a transparent manner, (Fig. 8, col. 13, line 1-36, col. 26, line 61-67 input/output interfaces (I/O ports), and it is inherent logic gates are provided by FPGA. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have been motivated to implement a transparent system that includes a receiver that extracts data signals and timing information as taught by Miller with the teachings of Hershey for the purpose of mapping and synchronization in a high data rate system.

Allowable Subject Matter

3. Claims 2, 4, 7, 11, 12 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Regarding claims 2, 4, 11, 12, the limitation "PUT translates said user signal to a data signal whenever said rate R. corresponds to a provisioned first protocol and passes said user signal unchanged whenever said rate R. is not recognized by processing unit" is absent from the art.

Regarding claims 7 and 15, the limitation, "set performance parameters includes a previous section fail indicator" is absent from the art.

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4. Claims 18-22 are allowed over prior art.

Regarding claim 18, the limitation, "detecting the rate (R.) of a continuous digital signal and determining a first protocol corresponding to said rate (R.), translating said set of performance parameters from said first protocol to a second protocol characterizing said container signal and providing said translated set into said container signal" is absent from the art. Claims 19-22 depend on claim 18, therefore, claims 19-22 are allowed as well.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prenell Jones whose telephone number is (703) 305-0630. The examiner can normally be reached on Monday thru Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin, can be reached on (703) 305-4366. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Prenell Jones

February 24, 2003

A handwritten signature in cursive script, appearing to read "Prenell Jones", written over the typed name and date.